

Docket No.: INTEL-0062

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

**EXPEDITED PROCEDURE
UNDER 37 C.F.R. §1.116**

Peter HAZUCHA et al.

Serial No.: 10/813,169

Group Art Unit: 2816

Confirmation No.: 4484

Examiner: Dinh Thanh Le

Filed: 3/31/2004

Customer No.: 49623

For: RESONANCE SUPPRESSION CIRCUIT

REQUEST FOR RECONSIDERATION

U.S. Patent and Trademark Office
Customer Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants respectfully request reconsideration of the rejections set forth in the Office Action dated August 2, 2005. Claims 1-4, 6-9, 11-17 and 19-24 are pending in this application. In view of the legal issue in question, applicants respectfully request immediate review of this application and the withdrawal of the finality of the Office Action.

The present paper is being provided based on an August 29 telephone conference between applicants' undersigned attorney and Examiner Le. During that conversation, applicants briefly explained that the Office Action's rejection was improper since one of the cited references should be disqualified as prior art under 35 U.S.C. §103(c) as previously

described in the Amendment filed May 31, 2005. Examiner Le requested applicants' undersigned attorney to again provide the arguments in a formally filed paper.

The Office Action rejects claims 1-4, 6-9, 11-17 and 19-24 under 35 U.S.C. §103(a) over previously cited U.S. Patent Publication 2004/0124715 to Huang et al. (hereafter Huang) in view of U.S. Patent 4,961,643 to Sakai et al. (hereafter Sakai). The rejection is respectfully traversed.

As explicitly stated in the May 31, 2005 response, it is respectfully submitted that 35 U.S.C. §103(c) applies in the present application in order to disqualify Huang as prior art. In particular, the rejection appears to be based on Huang qualifying as prior art under 35 U.S.C. §102(e). Applicant respectfully notes that 35 U.S.C. §102(b) does not apply since the present application was filed prior to the publication date of Huang.

Huang and the present application were commonly assigned at the time of the invention to Intel Corporation. That is, Huang was assigned to Intel Corporation by virtue of an assignment recorded at Frame 013627/0065 and recorded at the Patent Office on December 31, 2002. The present application has also been assigned to Intel Corporation by virtue of an Assignment filed at the Patent Office on March 31, 2004. These statements and arguments were previously recited in the response filed May 31, 2005. As such, the present application is subject to the provisions of 35 U.S.C. §103(c). More specifically, since an obviousness rejection under 35 U.S.C. §103(a) has been made (based upon a 35 U.S.C. §102(e) reference), then Huang may not be used as prior art due to 35 U.S.C. §103(c).

35 U.S.C. §103(c)(1) explicitly states:

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In response to the arguments made on May 31, 2005, the Office Action states on page 4 that “the argument is not persuasive as the Huang reference is still qualified as prior art under 35 U.S.C. §103(a).” Applicant respectfully submits that this is an incorrect statement of the law. As stated by applicant during the telephone conference on August 29, Huang is disqualified under U.S. patent law under 35 U.S.C. §103(c) for at least the reasons as discussed above. Applicants respectfully request the Examiner to review M.P.E.P. §706.02(l)(1) and §706.02(l)(2) for further information regarding 35 U.S.C. §103(c). Applicants respectfully submit that upon review, Huang should be disqualified as prior art. Examiner Le is requested to contact applicants’ undersigned attorney if any further questions apply as to 35 U.S.C. §103(c) and/or whether any documentation is required. Applicants also respectfully submit that Sakai does not teach or suggest all the features of each of the claims. Thus, each of the pending claims defines patentable subject matter.

Applicants have already made these arguments in the response filed May 31, 2005. Therefore, applicants believe that the finality of the present Office Action should be withdrawn immediately as these arguments were previously and properly made. The issuance of the final Office Action is improper and applicants should not be penalized based on the pending Office Action.

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In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-4, 6-9, 11-17 and 19-24 are earnestly solicited. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **David C. Oren**, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
FLESHNER & KIM, LLP



David C. Oren
Registration No. 38,694
Attorney for Intel Corporation

P.O. Box 221200
Chantilly, Virginia 20153-1200
703 766-3701 DCO/kah

Date: August 31, 2005

Please direct all correspondence to Customer Number 49623